



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/777,572	02/11/2004	David Burton	24,577-45CIP	6003

7590 05/03/2006

John F. Klos, Esq.  
Fulbright & Jaworski L.L.P.  
80 South Eighth Street, Suite 2100  
Minneapolis, MN 55402-2112

EXAMINER
----------

ALI, SHUMAYA B

ART UNIT	PAPER NUMBER
----------	--------------

3743

DATE MAILED: 05/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/777,572

Applicant(s)

BURTON, DAVID

Examiner

Shumaya B. Ali

Art Unit

3743

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 2/11/04.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☒ Other: detailed action.

**DETAILED ACTION**

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. **Claims 1, 4-26, 28-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miles US Patent No. 5,353,788**

**As to claims 1, 26, Miles disclose a mask assembly (3,26) comprising:**  
a body (see fig.2, attachment below) having an internal surface (see fig.2, mask inherently have external and internal surface), an external surface (see fig.2, attachment below), and a perimeter surface (see fig.2 attachment below); and a forehead support (see fig.2 attachment below) connected to the body, however does not disclose the forehead support having an EEG sensor located thereon, however, the location of the sensor is not considered critical, (see col.4. lines 33-35, lines 44-45; lines 55-59; col.5 lines 615, and col.7 lines 37-51 which disclose a plurality and variety of sensors including an EEG sensor and further teach that the sensor may be mounted inside the mask or connected to the mask, it should also be noted that the physiological specific sensor, thereby recited limitation cited in claims 4, 5-7, 28, 29 is located on the respective/correspond anatomy as shown in Fig.2 and therefore, it would have been obvious to one of ordinary skill in the art to place an EEG, which inherently measure/detect brain activity near or on the head and away from mask, i.e. forehead support, in order to get a more precise reading).

**As to claims 8-16, 23,30,31 Miles discloses limitation as cited for claim 1** and a processor in communication with the gas delivery device and the sensor, the processor adapted to determine the existence of a sleep disorder and to adjust the gas delivery setting based thereon (see fig.2).

**As to claims 17-22,25, Miles discloses limitation as cited for claims 1,8-16,23,30.** Therefore the structures sited in those claims can be used to perform method steps cited in claims 17-22, and 25.

**3. Claims 2,3,27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miles US Patent No. 5,353,788 in view of Kwok US Patent No. 6532961 B1**

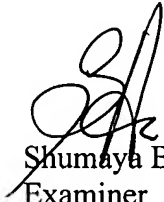
**As to claims 2,3, and 27 Miles does not disclose respectively padding and forehead support bar, however mask with such features are well known in the art. Kwok teaches padding (25) and forehead support bar (12). Therefore, it would have been obvious to one of ordinary skills in the art at the time of the invention to include padding and bar to the mask of Miles in view of Kwok for the purposes of providing cushioning to the forehead using padding and enhance strap attachment with comfort around the forehead (see Kwok col.4 lines 15-20, and 40-45)**

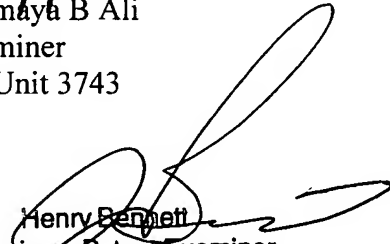
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shumaya B. Ali whose telephone number is 571-272-6088. The examiner can normally be reached on M-F 8:30-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Henry Bennett can be reached on 571-272-4791. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3743

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

 5/1/06  
Shumaya B Ali  
Examiner  
Art Unit 3743

  
Henry Bennett  
Supervisory Patent Examiner  
Group 3700

Art Unit: 3743

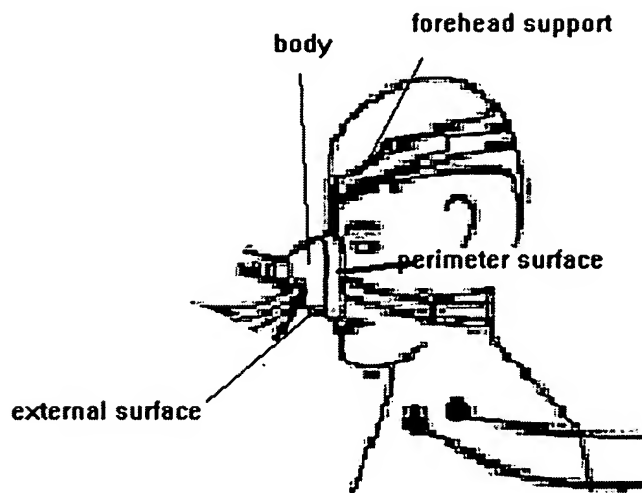


Figure 2  
**U.S. Patent**  
**5,353,788**